

REMARKS

Claims 1-5, 7-10, 15, and 17-26 were pending in this application.

Claims 1-5, 7-10, 15, and 17-26 have been rejected.

Claims 1, 7, 15, 22, 24, and 26 have been amended as shown above.

Claims 1-5, 7-10, 15, and 17-26 remain pending in this application.

Reconsideration and full allowance of Claims 1-5, 7-10, 15, and 17-26 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 112

Claims 1-5, 7-10, and 15-26 have been rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action asserts that the phrase “capable of rendering the content material a limited number of times prior to the purchase request ...” in Claims 1, 7, and 15 was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time of filing. (*Office Action, Page 2, Last paragraph – Page 3, First paragraph*).

The Applicants’ specification clearly supports these recitations in Claims 1, 7, and 15. For example, the Applicants’ specification clearly recites that content material 11 may be provided from a content provider 10 “for a once-only rendering.” (*Application, Page 4, Lines 12-13*). If a consumer decides to purchase the content material 11, a “purchase request” is sent to the content provider 10. (*Application, Page 4, Lines 13-26*). While the content material 11 is stored in a memory, the content material 11 cannot be subsequently rendered until the purchase request is submitted and an

“authorization for subsequent renderings” is received. (*Application, Page 5, Lines 3-7*).

These and other portions of the Applicants’ specification clearly support “rendering the content material a limited number of times prior to the purchase request and subsequently rendering the content material additional times after an authorization is received in response to the purchase request” as recited in Claims 1, 7, and 15. As a result, the claimed invention is described in the Applicants’ specification in such a way as to reasonably convey to one skilled in the art that the inventors had possession of the claimed invention at the time of filing.

Accordingly, the Applicants respectfully request withdrawal of the § 112 rejection.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1, 2, 4, 5, 7-9, 15, 16, 19-21, 23, and 25 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,991,737 to Chen (“*Chen*”) in view of U.S. Patent No. 5,892,900 to Ginter (“*Ginter*”). The Office Action rejects Claims 3 and 10 under 35 U.S.C. § 103(a) as being unpatentable over *Chen* and *Ginter* in further view of U.S. Patent No. 5,991,601 to Anderson (“*Anderson*”). The Office Action rejects Claims 22 and 24 under 35 U.S.C. § 103(a) as being unpatentable over *Chen* and *Ginter* in further view of U.S. Patent No. 6,708,157 to Stefik (“*Stefik*”). The Office Action rejects Claims 17 and 18 under 35 U.S.C. § 103(a) as being unpatentable over *Chen*, *Ginter*, and *Anderson* in further view of U.S. Patent No. 5,949,492 to Mankovitz (“*Mankovitz*”). These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262,

23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. (MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (MPEP § 2142).

Claim 1 recites a "rendering device" capable of rendering "content material" a "limited

number of times prior to [a] purchase request” and “subsequently rendering the content material additional times after an authorization is received in response to the purchase request.” The Office Action acknowledges that *Chen* fails to disclose these elements of Claim 1. (*Office Action, Page 4, Second paragraph*). The Office Action then asserts that *Ginter* discloses these elements of Claim 1 and that it would be obvious to combine *Chen* and *Ginter*. (*Office Action, Page 4, Second paragraph*).

The Office Action fails to establish that a person skilled in the art would implement the mechanism of *Ginter* in the system of *Chen* to render the invention recited in Claim 1 obvious.

The Office Action relies on components in the remote processing station 22 of *Chen* as anticipating the “content access device” recited in Claim 1. (*Office Action, Page 3, Section 9, Second paragraph*). The Office Action also relies on components in the remote processing station 22 of *Chen* as anticipating the “rendering device” recited in Claim 1. (*Office Action, Page 3, Last paragraph*).

The remote processing station 22 of *Chen* is not an end-user device used by a customer. Rather, the remote processing station 22 of *Chen* is used to support the fulfillment of orders placed by customers who receive radio and television broadcasts. The remote processing station 22 of *Chen* may analyze the television or radio broadcasts to identify the contents (shows, advertisements, news, music, etc.). (*Col. 3, Lines 47-54; Col. 4, Lines 41-54*). The identified audio or visual contents from the broadcasts are then stored, and the identified contents are used to allow an order processor 36 to determine which products are being ordered by the customers. (*Col. 4, Lines 54-60*).

First, the Office Action provides no explanation as to why the remote processing station 22 of

Chen needs to be limited to rendering content material only a “limited number of times” prior to a “purchase request” as recited in Claim 1. The remote processing station 22 of *Chen* receives television and radio broadcasts, analyzes the received broadcasts, and identifies the audio or visual contents of the broadcasts. The identified contents are then stored (presumably in a database or other memory).

At this point, the remote processing station 22 of *Chen* has completed its use of the received broadcasts. The received broadcasts do not need to be processed again or used in any other way by the remote processing station 22 of *Chen*. In other words, assuming that the remote processing station 22 of *Chen* “renders” the received broadcasts during the analysis, the remote processing station 22 renders the received broadcasts once to identify their contents. No other renderings need to be performed by the remote processing station 22 of *Chen*. As a result, the remote processing station 22 of *Chen* need not be limited to rendering content material only a “limited number of times” prior to a “purchase request” as recited in Claim 1.

Second, the Office Action fails to explain why the remote processing station 22 of *Chen* would need to render the received broadcasts after an “authorization” is received “in response to [a] purchase request.” The remote processing station 22 of *Chen* analyzes the received broadcasts and identifies the audio or visual contents. The identified contents are then used to fulfill orders for products placed by customers who also received the broadcasts. While the orders from the customers may represent purchase requests, the remote processing station 22 of *Chen* never renders the received broadcasts again after an “authorization” is received in response to the customer orders. As a result, there is no need to for the remote processing station 22 of *Chen* to render the received

broadcasts additional times after an “authorization” is received “in response to [a] purchase request” as recited in Claim 1.

Third, Claim 1 has been amended to recite that the “rendering device” is configure to render the content material “to a user.” *Chen* lacks any mention that the remote processing station 22 renders content material to a user.

Based on this, the Office Action has not established that a person skilled in the art would modify the remote processing station 22 of *Chen* with the mechanism of *Ginter* to make the “rendering device” recited in Claim 1 obvious.

For these reasons, the proposed *Chen-Ginter* combination fails to disclose, teach, or suggests the Applicants’ invention as recited in Claim (and its dependent claims). For similar reasons, the proposed *Chen-Ginter* combination fails to disclose, teach, or suggests the Applicants’ invention as recited in Claims 7 and 15 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 1-5, 7-10, 15, and 17-26.

III. CONCLUSION

The Applicants respectfully assert that all pending claims in the application are in condition for allowance and respectfully request an early allowance of such claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: _____

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